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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,073	05/13/1999	MINORU USUI	448563/163	2072

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EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/312,073

Applicant(s)

USUI ET AL.

Examiner

Michael P Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2002 and 24 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39, 41-65, 67-73 and 83-90 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 24-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-23, 48-61 and 87-90 is/are allowed.
- 6) ☒ Claim(s) 36-39, 41, 42, 46, 47, 62-65, 67, 68 and 73 is/are rejected.
- 7) ☒ Claim(s) 43-46, 69-72 and 83-86 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

The Amendment filed on March 5, 2002 has been acknowledged.

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2002 has been entered.

### ***Withdrawal of Allowability***

2. The indicated allowability of claims 42, 47, 68, and 73 are withdrawn in view of the newly discovered reference(s) to Miyazawa et al. (US 6,250,750). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-46, 68-72, and 83-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

How can a single recess comprise a plurality of recesses?

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 36-39, 41, 42, 46, 47, 62-65, 67, 68, and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyazawa et al. (US 6,250,750).

Miyazawa et al. discloses all the claimed limitations including:

- an ink jet printer (Fig. 11), comprising:
  - a carriage (101), said carriage having a projecting member and an ink supply needle (119) extending therefrom;
  - a print head (118) including a plurality of nozzles (nozzles of 118) through which ink is ejected mounted on said carriage (Fig. 12a);
  - an ink cartridge (120), said ink cartridge being mounted on the carriage (Figs. 12's) and, said ink cartridge comprising:
    - a housing (1) containing ink; an ink supply port (opening of 10) formed on a wall of said housing at an offset position (Fig. 1); and at least one engaging recess (15) formed in the wall of said housing adjacent to and apart from said ink supply port (Fig. 1),
    - said engaging recess being engageable with a projecting member (16) of the printer when the ink cartridge is mounted on the printer (Figs. 12's),
    - the engaging recess and the projecting member of the printer align the ink supply port with an ink supply needle (119) of the printer prior to the insertion of the ink needle into the ink supply port (Figs. 12's);
    - the height of the projecting member is greater than that of the ink supply needle of the ink jet printer (length of 117 extends across the ink cartridge body, column 8, line 67 – column 9, line 2 is longer than length of 119);

- an abutment member (wall of 10) which abuts against the projecting member of the ink jet printer when the ink cartridge is mounted improperly (if wall of 10 may abut 119 if the ink cartridge is mounted improperly);
- said abutment member includes a part of said wall of said housing where the engaging recess is not formed (Fig. 1);
- said ink supply port protrudes from said wall of said housing (Fig. 1);
- said engaging recess comprises an odd number of engaging recesses (one 15);
- said engaging recess is rectangular in cross section (Fig. 1).

#### ***Allowable Subject Matter***

5. Claims 15-23, 48-61, and 87-90 are allowed.
6. Claims 43-46, 69-72, and 83-86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Reasons For Allowance***

7. The combination as claimed wherein when the ink cartridge is packed, the pressure within a space being lower than the atmospheric pressure, wherein the recess is isolated from an interior of the ink chamber and exposed to an exterior of the ink

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chamber (claims 15, 58) or a plurality number of engaging recesses (claims 43-46, 69-72, 83-86) or at least one engaging recess formed on said lid, said engaging recess being engageable with a projecting member of the printer when the ink cartridge is correctly mounted on the printer and said engaging recess being at least partially covered by a film which can be removed from the ink cartridge to create an air communication port to the atmosphere (claims 57, 87) is not disclosed, suggested, or made obvious by the prior art of record.

### ***Response to Arguments***

8. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

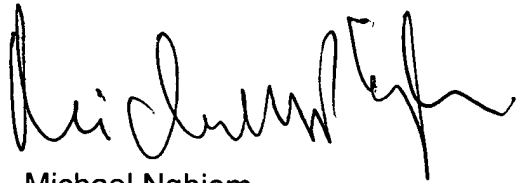
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-5841 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'Michael Nghiem', with a stylized flourish at the end.

Michael Nghiem

May 13, 2002